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Patent 9-12-00

Attorney's Docket No. 004968-005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
David R. FERGUSON et al.) Group Art Unit: 2771
Application No.: 08/947,435) Examiner: E. Colbert
Filed: October 8, 1997)
For: COMPUTER-BASED DOCUMENT)
MANAGEMENT SYSTEM)

RECEIVED
TC 2700 MAIL ROOM
SEP 11 2000

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed on June 7, 2000, wherein claims 1-28, 30-51 and 53-83 are pending, favorable reconsideration of the above-identified application is respectfully requested.

At the outset, the Applicants would like to thank Examiner Colbert for her courtesy and helpfulness during the Personal Interview conducted with the undersigned on August 30, 2000. A summary of the interview is submitted herewith under separate letter.

In paragraphs 7 and 8 of the Office Action, claims 1, 32, 33, 39, 51 and 53-58 are rejected under 35 U.S.C. 112, second paragraph as allegedly being "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." This rejection is respectively traversed.

The Office Action asserts that claims 1, 32, 33, 39, 51 and 53-58 are indefinite because the phrases, "predefined criteria", "predefined behavior", "predefining category criteria", and "category criteria" are allegedly not clear. Further, during the Interview conducted August 30, 2000, both Examiner Colbert and Primary Examiner Alam indicated to Applicants' representatives that it was the "breadth" of these phrases which prompted the

rejection under 35 U.S.C. 112, second paragraph. However, Applicants contend that this rejection is improper. MPEP §2173.04, citing *In re Miller*, 441 F.2d 689, 169 USPQ (CCPA 1971), states:

[b]readth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. 112, second paragraph.

In paragraph 9 of the Office Action, claims 1, 2 and 51 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 5,625,818 (herein "Zarmer"). This rejection is respectfully traversed.

Independent claim 1 defines a method for managing a document collection in a computer system. The method comprises several steps including, *inter alia*, the step of importing a document (e.g., an electronic letter, memo or e-mail message) into a collection of documents that is organized into a hierarchy of electronic folders. More importantly, however, the method includes the steps of storing the imported document into memory and extracting therefrom attribute data (e.g., title, author, document type, document size, document content). The attribute data extracted from the imported document is contained in a data structure that is separate from the imported document itself. Ultimately, the imported document is linked to an electronic folder, in the hierarchy of electronic folders, if the attribute data extracted from the imported document and contained in the separate data structure matches a set of predefined criteria corresponding to the at least one electronic folder.

Zarmer discloses an electronic publishing tool for managing information which is to be provided to an online service. The electronic publishing tool of Zarmer allows information (i.e., the content to be published online) to be captured from the provider so that it may be "published" on a variety of platforms with minimal additional effort. To accomplish this, the publishing tool of Zarmer uses an object-oriented representation of the content to be published and provides a system for the storage of content objects,

synchronization of changes to the content and interfaces to other systems (See Zarmer at column 2, lines 13-24). However, Zarmer fails to disclose or suggest all the features of the present invention as defined by independent claim 1.

More specifically, Zarmer fails to disclose or suggest the steps of "automatically extracting attribute data from the document" (i.e., the imported document), "generating a data structure for the document, wherein said data structure contains the attribute data in a second format independent of said first format, and wherein said data structure is stored and maintained in memory separate from the imported document", and "linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder." Nevertheless, the Office Action contends these steps are disclosed by Zarmer.

To support the contention that Zarmer discloses "automatically extracting attribute data from the document", the Office Action points to Zarmer at column 18, lines 24-34. The cited passage of Zarmer (column 18, lines 24-34) discloses that text documents are represented by the object class "TEDocument" and may contain attributes such as first displayed date, modification date and text size. However, the mere existence of attribute data does not disclose the step of automatically extracting the attribute data.

To support the contention that Zarmer discloses the step of generating a data structure for the document, wherein said data structure contains the attribute data in a second format independent of said first format, and wherein said data structure is stored and maintained in memory separate from the imported document, the Office Action points to Zarmer at column 23, lines 40-51, column 24, lines 48-63, and column 4, lines 43-52. The cited passages merely disclose that "Folders" can be used for a variety of purposes, for example, to represent a hierarchy or directory structure (column 23, lines 40-51), that folders are not "Documents" (column 24, lines 48-63) and that changes are effected through the processing of change files (column 4, lines 43-52). Moreover, none of the above-cited sections mentions a text document with attributes such as those described in column 18, lines 24-34, i.e., the section of Zarmer cited as allegedly disclosing extracting attribute information. Accordingly, Zarmer does not disclose the step of generating a data structure

containing *the attribute data* extracted from the imported document and storing the data structure in memory separate from the imported document.

To support the contention that Zarmer discloses the step of linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder, the Office Action cites Zarmer at column 6, lines 12-15 and lines 35-40. The cited passage merely discloses that documents may be imported (lines 12-15) and that if a file to be imported has the same name, excluding the file extension, as an existing file, then the file will be imported as an attachment to the existing file. During the Interview the Examiner explained that the "dot extension" disclosed by Zarmer at column 16, lines 35-40 allegedly anticipates the attribute data recited in the linking step of Applicants' claim 1. However, even if one were to equate the extension of a file to be imported as equivalent to the attribute data of the present invention, Zarmer still fails to render the present invention unpatentable.

First, as disclosed in Zarmer at column 6, lines 35-40, it is not the "dot extension" that is the basis for determining whether or not to import the document as an attachment, but rather the file name, excluding the "dot extension" which is used. Second, the "dot extension" as disclosed in Zarmer is not automatically extracted from the imported document, nor is the "dot extension" contained in a data structure which is stored and maintained separate from the imported document. Therefore, it can not be concluded that the imported document is linked to a first electronic folder if **the attribute data contained in the data structure** matches a set of predefined criteria. Moreover, the above-cited section does not mention a text document with attributes such as those described in column 18, lines 24-34, i.e., the section of Zarmer cited as allegedly disclosing extracting attribute information.

Independent claim 51 defines a computer-readable storage medium having stored therein a program which executes steps that are substantially similar to the steps recited in claim 1. In addition, dependent claim 2 depends from independent claim 1. Therefore, claims 2 and 51 are patentably distinguishable over Zarmer for at least those reasons

presented above with respect to claim 1. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 2 and 51 under 35 U.S.C. §102 in view of Zarmer.

In paragraph 10 of the Office Action, claims 3-10 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Zarmer in view of U. S. Patent No. 5,628,003 (herein "Fujisawa"). This rejection is respectfully traversed.

Dependent claims 3-10 variously depend from independent claim 1. As discussed above, Zarmer fails to disclose all the features of claim 1. Further, Zarmer does not suggest all of the features of claim 1. In addition, Fujisawa does not overcome the above-identified deficiencies of Zarmer. Accordingly, the combination of Zarmer and Fujisawa does not disclose or suggest the steps of "automatically extracting attribute data from the document" (i.e., the imported document), "generating a data structure for the document, wherein said data structure contains the attribute data in a second format independent of said first format, and wherein said data structure is stored and maintained in memory separate from the imported document", and "linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder."

Therefore, claims 3-10 which variously depend from claim 1, are patentably distinguishable over the combination of Zarmer and Fujisawa for at least those reasons stated above with regard to claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3-10 under 35 U.S.C. §103(a) over Zarmer in view Fujisawa.

In paragraph 11 of the Office Action, claims 11-28 and 30-46 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Zarmer in view of Fujisawa further in view of U. S. Patent No. 5,727,175 (herein "Malone"). This rejection is respectfully traversed.

Dependent claims 11-28 and 30-46 variously depend from independent claim 1. As discussed above, Zarmer and Fujisawa fail to disclose all the features of claim 1. Further, Zarmer and Fujisawa do not suggest all of the features of claim 1. In addition, Malone

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does not overcome the above-identified deficiencies of Zarmer and Fujisawa. Accordingly, the combination of Zarmer, Fujisawa and Malone does not disclose or suggest the steps of "automatically extracting attribute data from the document" (i.e., the imported document), "generating a data structure for the document, wherein said data structure contains the attribute data in a second format independent of said first format, and wherein said data structure is stored and maintained in memory separate from the imported document", and "linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder."

Therefore, claims 11-28 and 30-46 which variously depend from claim 1, are patentably distinguishable over the combination of Zarmer, Fujisawa and Malone for at least those reasons stated above with regard to claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 11-28 and 30-46 under 35 U.S.C. §103(a) over Zarmer in view of Fujisawa further in view of Malone.

Applicants believe the application is in condition for allowance. Notice of same is earnestly solicited. If the Examiner has any questions regarding this application, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

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